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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/338,063	06/23/99	GOTO	M FJN-060DV2(3)

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HM12/0816

EXAMINER

EWOLDT, G

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 08/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/338,063

Applicant(s)
Goto et al.

Examiner
Gerald Ewoldt

Group Art Unit
1644



☒ Responsive to communication(s) filed on May 16, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 32-36 is/are pending in the application.

Of the above, claim(s) 36 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 32-35 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. Applicant's amendment, response, and substitute specification, filed 5/16/00, are acknowledged.
2. Claims 32-36 are pending.
Claims 32-35 are being acted upon.
3. Claim 36 stands withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to a nonelected invention.
4. In view of Applicant's amendment and response, filed 5/16/00, only the following rejection remains.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless --
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
6. Claims 32-35 stand rejected under 35 U.S.C. 102(a) as being anticipated by WO97/23614 (IDS).

WO97/23614 teaches a 401 amino acid protein of approximately 60 kD which contains the claimed SEQ ID NOS: 1-3 and inhibits osteoclast differentiation. The reference also teaches both polyclonal and monoclonal antibodies to said protein (see particularly Figures 9C-D and pages 32-33, Antibodies). Claim 35 is included because it would be an inherent property of a monoclonal antibody that it would have a molecular weight of about 150,000 D and be of the IgG₁, IgG_{2a}, or IgG_{2b} subclass.

The reference teaching clearly anticipates the claimed invention.

Applicant's arguments, filed 5/16/00, have been fully considered but have not been found persuasive. Applicant argues that priority documents JP 54977/1995 and JP 207508/1995 antedate the WO97/23614 reference's priority date of 12/22/1995, and that similar arguments were made to overcome similar rejections in the parent case of the instant application, U.S. application 08/915,004. However, an English language translation of priority document PCT/JP96/00374 (2/20/96) was the only translation provided in the parent application, thus 2/20/96 (the filing date of the translated document) is the earliest priority date that can be granted to the instant application. Because no English translations of JP 54977/1995 and JP 207508/1995 have been provided, priority dates based on said documents cannot be granted.

7. No claim is allowed.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Friday from 8:00 am to 5:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

G.R. Ewoldt, Ph.D.
Examiner
Technology Center 1600
August 2, 2000

Christina Chan
CHRISTINA Y. CHAN
SUPERVISORY PATENT EXAMINER
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